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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RALPH S. HOEFELMEYER and THERESA S. PHILLIPS

Appeal 2009-005828
Application 09/911,592¹
Technology Center 2400

Before JOSEPH L. DIXON, JAY P. LUCAS, and STEPHEN C. SIU,
Administrative Patent Judges.

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL²

¹ Application filed July 24, 2001. The real party in interest is Verizon Corporation.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

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STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 1 to 15 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

We affirm the rejections.

Appellants' invention relates to a computer virus-scanning system for efficiently scanning e-mail for malicious code arriving at a plurality of intranets (claim 1). In the words of Appellants:

[The] invention [provides] a scalable layered, network security architecture that comprises a combination of server-based and client-based anti-virus scanning components in conjunction with a firewall for diverting suspect traffic to decoy servers. This network security architecture can be deployed between the organization's intranet and the internet backbone and can be shared between various organizations, thereby providing the economies of scale that conventional network security solutions lack.

(Spec. 3, ¶ [04]).

The following claim illustrates the claims on appeal:

Claim 1:

1. A network security system to be deployed between a plurality of intranets belonging to

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respective organizations and an internet backbone, comprising:

a scanning system coupled to the intranets for scanning incoming electronic mail for malicious code;

an anti-virus server coupled to the intranets for downloading anti-virus code to clients coupled to the intranets; and

a switch coupled between the internet backbone, the scanning system, and the anti-virus server, said switch configured for:

directing incoming electronic mail from the internet backbone to the scanning system.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Hypponen US 2003/0191957 A1 Oct. 9, 2003
(Feb. 19, 1999)

Yanovsky US 7,010,807 B1 Mar. 7, 2006
(Apr. 13, 2001)

Network Associates Ships CyberCop Sting-Industry's First 'Decoy' Server Silently Traces and Tracks Hacker Activity (1999), available at <http://www.prnewswire.com/cgi-bin/stories.pl?ACCT=104&STORY=/www/story/07-141999>.

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REJECTIONS

The Examiner rejects the claims as follows:

R1: Claims 1, 3, 5, 8, and 10 stand provisionally rejected for obviousness-type double patenting over claims 1, 4, 7, 11, and 14 of co-pending Application No. 10/024,202.

R2: Claims 1, 3, 5, 6, 8, and 10 to 15 stand rejected under 35 U.S.C. § 103(a) for being obvious over Hypponen in view of Yanovsky.

R3: Claims 2, 4, 7, and 9 stand rejected under 35 U.S.C. § 103(a) for being obvious over Hypponen in view of Yanovsky further in view of NAI.

We have only considered those arguments that Appellants actually raised in the Briefs. Arguments Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

The issues involve whether Appellants have shown that the Examiner erred in rejecting the claims under obviousness-type double patenting and under 35 U.S.C. § 103(a). The issue under 35 U.S.C. § 103(a) turns on whether Hypponen and Yanovsky render obvious Appellants' claimed "system to be deployed between a plurality of intranets" (claim 1). More specifically, the issue is whether the Examiner's finding of a single intranet in the prior art meets Appellants' claim limitation.

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FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Disclosure

1. Appellants have invented a network security scanning system to be deployed between a plurality of intranets (claim 1). The system's purpose is to scan e-mail for malicious code (*id.*). Appellants disclose that an advantage of the claimed invention is achieving economies of scale by having one scanning system protecting multiple organizations (Spec. 3, ¶ [04]).

Co-pending Application No. 10/024,202

2. Appellants' co-pending patent application has not resulted in the issuance of a patent as of the mailing of this final decision.

Hypponen

3. The Hypponen reference discloses a network security scanning system for a TCP/IP network (¶¶ [0011] to [0013], [0034]). The system's purpose is to scan data traffic for viruses (¶ [0011]).

PRINCIPLE OF LAW

Appellants have the burden on appeal to the Board to demonstrate Examiner error. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

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ANALYSIS

Arguments with respect to the obviousness-type double patenting rejection of claims 1, 3, 5, 8, and 10 [R1]

The Examiner rejected the noted claims as being obvious over claims in the co-pending application, Examiner's Answer pages 3 to 4.

Since neither the application before us nor the co-pending application have resulted in the issuance of a patent (FF#2), we do not treat Appellants' arguments concerning the obviousness-type double patenting issue (App. Br. 10, top to 11, middle). We rely upon the CAFC's recent ruling in *Sun Pharmaceutical Industries, Ltd., v. Eli Lilly and Company*, Case No. 2010-1105 *15, July 28, 2010, for guidance: “[T]he double patenting doctrine is concerned with the issued patent and the invention disclosed in that issued patent, not earlier drafts of the patent disclosure and claims.”

In this case, no patent has issued for either the present or co-pending application. In view of *Sun Pharmaceutical*, we do not address the Examiner's rejection under non-statutory obviousness-type double patenting.

Arguments with respect to the rejection of claims 1, 3, 5, 6, 8, and 10 to 15 under 35 U.S.C. § 103(a) [R2]

The Examiner has rejected the noted claims for being obvious over Hypponen and Yanovsky, Examiner's Answer pages 4 to 7.

Appellants argue that each claim requires a “plurality of intranets,” whereas the Hyponnen reference merely discloses a single computer data network 1 (App. Br. 12, middle).

“[M]ere duplication of parts has no patentable significance unless a new and unexpected result is produced.” *See In re Harza*, 274 F.2d 669, 671 (CCPA 1960) (The claims recited a plurality of “ribs” for water sealing a container, whereas the prior art disclosed a single, flexible water stop for preventing water passage. Although the reference disclosed just one seal, and not the plurality of “ribs,” the court held that duplicative parts have patentable significance only if the parts produce a new and unexpected result.).

We agree with the Examiner. We find that Appellants have invented a network security scanning system to be deployed between a plurality of intranets (FF#1). We find that the system’s purpose is to scan e-mail for malicious code (*id.*). Appellants disclose that an advantage of the claimed invention is achieving economies of scale by having one scanning system that protects multiple organizations (*id.*). In comparison, the Hyponnen reference discloses a network security scanning system for a TCP/IP network (FF#2). Hyponnen’s system scans data traffic for viruses (*id.*).

In this case, the claimed invention differs from the Hyponnen reference only insofar as a “plurality of intranets” is recited in claim 1. We find the “plurality of intranets” to be merely a duplication of one part (*i.e.*, an intranet), since Appellants disclose that the purpose of the plurality of

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intranets (versus a single intranet) is to create economies of scale (FF#1). In accordance with *Harza*'s teachings and the above-stated analysis, we find that Appellants failed to demonstrate error in the Examiner's rejection R2. Accordingly, we affirm.

*Arguments with respect to the rejection
of claims 2, 4, 7, and 9
under 35 U.S.C. § 103(a) [R3]*

The Examiner has rejected the noted claims for being obvious over Hypponen, Yanovsky, and NAI, Examiner's Answer pages 7 to 8.

With respect to claims 2, 4, 7, and 9, Appellants make a similar argument as stated above regarding the claimed "plurality of intranets." (App. Br. 8, middle to 9, top). Since we already addressed this argument (*see* discussion of R2, *supra*), we need not re-address it here. We thus affirm the rejection R3.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have not shown that the Examiner erred in rejecting claims 1 to 15.

DECISION

We affirm the Examiner's rejections [R1 and R2] of claims 1 to 15.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

rwk

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